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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,058	07/17/2003	Mark Linehan	SOM919980031US2	2265
58776	7590	01/08/2007	EXAMINER	
RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/622,058	LINEHAN, MARK
	Examiner Calvin L. Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 December 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4,15-18,24-29 and 55-61 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1, 2, 4, 15-18, 24-29, 55-58, and 61 is/are allowed.

6) Claim(s) 59 and 60 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1, 2, 4, 15-18, 24-29 and 55-61 have been examined.
2. Claims 1, 2, 4, 15-18, 24-29, 55-58 and 61 are allowed.

***Response to Amendments/Arguments***

3. Applicant has amended claims 59 and 60 in order to overcome the applied 102, 112 second, and 101 rejections. However, the Examiner maintains the rejections for the following reasons:

It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, the memory and processor of Grube et al. (figure 2; column 4, lines 8-30) is sufficient in terms of anticipation as the intended use (e.g. “operative to...”, “such that the merchant’s computer...”, “so as to capture...”) of Applicant’s claimed apparatus [claim 59] does not distinguish it from the apparatus of the prior art. Regarding the 112 second paragraph rejection, it is unclear to one of ordinary skill what Applicant is claiming. Claim 59 is directed to

an apparatus comprising a memory and a processor, however, Applicant continues to attempt to further limit the claim by reciting limitations that are unrelated to the apparatus or its structure. For example, claim 59 recites method steps relating to the contents of a "merchant message", the creator of a reference number (i.e. "the reference number having been created by... "), what is maintained by the issuing bank (i.e. "the issuing bank maintaining a table of credit card number or debit card numbers"), the activities of the merchant computer (i.e. "initiates fulfillment of the order description") the acquirer bank (i.e. "disburse payment"), and the issuing bank (i.e. "and further wherein the issuing bank, in response to a message from the acquirer bank).

Claim 60 is directed to a computer program stored on a computer readable medium. Giving the claim its broadest reasonable interpretation, the claim reads on a program listing stored on an optical disk as opposed to executable code when loaded or run on a computer causes the computer to perform a particularly task.

The MPEP (2106.01 "Computer-Related Nonstatutory Subject Matter") is clear,

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101.

However, the MPEP (2106.01, I, "Functional Descriptive Material") also states,

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 60 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 60 is non-statutory because it is directed to a computer program not stored on a computer readable medium (MPEP, 2100-12, first column, first full paragraph; 2100-13, second column, second paragraph).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 59 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 59 is directed to an apparatus wherein the apparatus is for use in a gateway. Specifically, the apparatus comprises a memory and a processor. The claim, then goes on to describe the apparatus in terms of what happens at the gateway, however, it is not clear to one of ordinary skill whether the processor ever receives, for example "information associated with the consumer computer and a message" or whether it controls the gateway such that the gateway is able to receive the information and message (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Further, Applicant describes the apparatus' processor in terms of method steps (e.g. the merchant's computer "receives the authorization token...", "initiates fulfillment..." and the issuing bank "converts the reference number..." and "applies payment"). However, this renders the claim indefinite as it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim does not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548).

Claim 61 recites the language "such that the merchant message will be sent...". To one of ordinary skill, however, the Applicant has not made it clear

whether this language is intended use ("such that") or that the message is ever sent ("will be sent").

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 59 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grube et al., U.S. Patent No. 5,594,796.

Grube et al. teach an apparatus for use in a gateway comprising memory and a processor coupled to said memory (figure 2; column 4, lines 8-30).

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

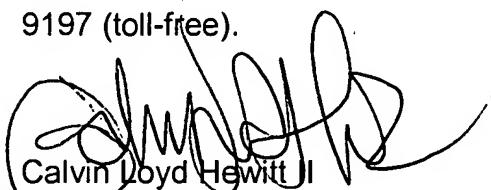
filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Lloyd Hewitt  
Primary Examiner

December 29, 2006